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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,504	10/02/2003	Lawrence J. Wrass	64556-0202	8254
44200	7590	11/03/2006	EXAMINER	
HONIGMAN MILLER SCHWARTZ & COHN LLP			SPAHN, GAY	
38500 WOODWARD AVENUE			ART UNIT	
SUITE 100			PAPER NUMBER	
BLOOMFIELD HILLS, MI 48304-5048			3635	

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/677,504	Applicant(s) WRASS, LAWRENCE J.	
	Examiner Gay Ann Spahn	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions - Restriction Requirement

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-20, drawn to a wall system, classified in class 52, subclass 267.
- II. Claim 21, drawn to a panel, classified in class 52, subclass 309.12.
- III. Claims 22-24, drawn to method of forming a panel, classified in class 264, subclass 255.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the claimed combination does not require a stud extending through a face of the concrete member or the foam core. The subcombination has separate utility such as utilization as a floor or roofing panel.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if

Art Unit: 3635

any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Inventions II and I/II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case claimed panel can be manufactured as by pouring foam over the concrete member or by extending incisions along the foam within which the studs are placed.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Election/Restrictions - Election of Species

This application contains claims directed to the following patentably distinct species:

SPECIES I - Fig. 3;

OR

SPECIES II - Fig.4

Art Unit: 3635

The species are independent or distinct because:

SPECIES I (i.e., Fig. 3) is a party wall system (20) including a party wall panel (30) comprised of a foam portion (32) and a concrete portion (44), wherein C-shaped channel studs (38) having a porous member (58) affixed to the inner surface of the upper cap (56) are embedded within both the concrete portion (44) and the foam portion (32) of the party wall panel (30), wherein C-shaped channel studs (36) have only their upper cap and most of their web, but not their lower cap embedded in only the foam portion (32) of the party wall panel (30), the unembedded lower cap acting as a spacer to space the foam portion (32) of the party wall panel (30) from a first pair of fire resistant sheets (24, 24), wherein z-shaped spacers (22, 22, . . .) space the concrete portion (44) of the party wall panel (30) from a second pair of fire resistant sheets (24, 24), and wherein the concrete portion (44) of the party wall panel (30) forms support columns (46) having a pair of reinforcing bars (48, 48) therein between the outermost two studs (38, 38) and forms edge caps (42) on the end of the party wall panel (30); and

SPECIES II (i.e., Fig. 3) is a party wall system (120) including a party wall panel (130) comprised of a foam portion (132) and a concrete portion (144), wherein C-shaped channel studs (138) having a space (160) between the upper cap (156) and a cap wall (159) are embedded within both the concrete portion (144) and the foam portion (132) of the party wall panel (130), wherein C-shaped channel studs (136) have only their upper cap and most of their web, but not their lower cap embedded in only the foam portion (132) of the party wall panel (130), the unembedded lower cap acting as a spacer to space the foam portion (132) of the party wall panel (130) from a first pair of

Art Unit: 3635

fire resistant sheets (124, 124), wherein U-shaped spacers (126, 126, . . .) space the concrete portion (144) of the party wall panel (130) from a second pair of fire resistant sheets (124, 124), wherein the concrete portion (144) of the party wall panel (130) forms support columns (146) having a single reinforcing bar (148) therein between the outermost two studs (138, 138), and wherein the ends of the party wall panel (130) have tongue (150) and groove (151) for easily aligning adjacent party wall panels (130).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, independent claims 1, 21, and 22 appear to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

A telephone call was not made to request an oral election to the above Restriction Requirement and Election of Species Requirement due to the complexity of the election.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gay Ann Spahn whose telephone number is (571)-272-7731. The examiner can normally be reached on Monday through Thursday, 8:30 am to 7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko N. Slack can be reached on (571)-272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3635

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GAS
Gay Ann Spahn, Patent Examiner
October 29, 2006

Basil Keth
BASIL KETH
PRIMARY EXAMINER
10/30/06